

REMARKS

Claims 1-39 are pending in the instant application. Claims 1, 10, 17, 21, 30, and 37 are independent claims, and claims 2-9, 11-16, 18-20, 22-29, 31-36, 38, and 39 depend, respectively, from independent claims 1, 10, 17, 21, 30, and 37. The Applicants request consideration of the claims in view of the following remarks.

In connection with filing their Request for Continued Examination, Applicants amended the independent claims to clearly set forth that Applicants are claiming an online affordability determination. Applicants' system and method not only analyzes the buyer's credit online, but also informs the buyer of the likelihood of the buyer being approved for financing of a product being offered for sale online.

Applicants previously stated that the prior art of record, including specifically the Lent (USP 6,405,181) and Mandler (USP 5,732,400) references previously cited by the Examiner, does not disclose, teach or suggest an online affordability determination system. But while the latest Office Action concedes that neither the Lent nor the Mandler references teach, disclose or suggest determining whether a buyer can afford a product being sold online, ("No such specific language is presented in the claims") (*see* Office Action dated November 23, 2004, at p. 2), the Office Action states that the systems disclosed in the Lent and Mandler references are "inherently used for purchasing a product for sale on-line." (*Id.*)

The Applicants respectfully submit, however, that neither the credit card approval system disclosed in Lent, nor the financial clearinghouse disclosed in Mandler are inherently associated with the online affordability determination system, as claimed in the present application. For example, the Lent discloses an online credit card approval system, but does not disclose or

suggest using such credit card for purchasing a product being offered for sale online. Rather, once an applicant is approved, the Lent reference simply discloses sending a credit card to the applicant for use as the applicant sees fit. (“FDR handles the embossing of the card and delivering it to approved applicants.”) (See col. 4, lns. 44-47). At no time does the Lent reference even suggest that the applicant can use the credit card to purchase goods being sold online. Likewise, the Mandler reference discloses a financial clearinghouse that, once the buyer’s credit is approved, sends request for quotations to potential sellers. At no time does the Mandler reference suggest that these sellers are offering goods for sale online.

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See Manual of Patent Examining Procedure at § 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

See *id.*, citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). As noted above, neither the Lent nor that Mandler reference discloses that their particular system must necessarily be used to purchase goods being sold online. Applicants therefore respectfully submit that neither the cited art of record, nor the Office Action makes clear that the missing descriptive matter, said to be inherent, is necessarily present in the cited art of record.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teaching of the applied prior art.

See id., citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). The Office Action does not contain any basis in fact and/or technical reasoning to support the statement that both the Lent and Mandler references disclose “an affordability determination system inherently used for purchasing a product for sale on-line.” Absent a “basis in fact and/or technical reasoning” for the rejection of record, the Applicants respectfully request that the rejections in light of the Lent and Mandler references should be reconsidered and withdrawn.

CONCLUSION

Based on at least the foregoing, the Applicants believe that claims 1-39 are in condition for allowance. If the Examiner disagrees or has any question regarding this submission, the Applicants request that the Examiner telephone the undersigned at (312) 775-8000.

A Notice of Allowance is courteously solicited.

Respectfully submitted,

Dated: February 16, 2005

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